REMARKS

Claims 1-6, 11 and 14-15 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. This objection is overcome in view of the amendments to claims 1 and 11. Claims 1-6, 11 and 14-15 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This objection is overcome in view of the amendments to claims 1 and 11.

Claims 1-2 and 5-6 are rejected under 35 U.S.C. §102(e) as being anticipated by *Pole, II* (U.S. 6,496,888).

Applicants traverse this rejection on the grounds that this reference is defective in supporting a rejection under 35 U.S.C. §102.

Claim 1 includes: A computing system comprising:

a processor with various power state conditions, wherein the processor performs at a selectable operating mode;

a north-bridge controller initiating a processor reset signal input;

a south-bridge controller providing an interface for I/O devices to the processor;

means for resetting the processor;

a clock;

a power supply; and

a logic device interfaced to the processor, the north-bridge controller, the south-bridge controller, the clock, and the power supply, whereby the logic device asserts a transition to a different operating mode on the processor while the processor is in a deep sleep power state, and upon transition back to operating power state, the clock provides a

frequency and the power supply provides a voltage matched to the different operating mode, and whereby the logic device provides control signals to the processor to cause the deep sleep immediately after reset.

The PTO provides in MPEP §2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection the *Pole, II* patent must contain all of the claimed elements of independent claim 1. However, a logic device interfaced to the processor, the north-bridge controller, the south-bridge controller, the clock, and the power supply, whereby the logic device asserts a transition to a different operating mode on the processor while the processor is in a deep sleep power state, and upon transition back to operating power state, the clock provides a frequency and the power supply provides a voltage matched to the different operating mode, and whereby the logic device provides control signals to the processor to cause the deep sleep immediately after reset as claimed, are not shown or taught in the *Pole, II* patent. Therefore, the rejection is unsupported by the art and should be withdrawn.

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. Of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." "The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Therefore, independent claim 1 and its respective dependent claims are not anticipated by *Pole, II.*

Claims 3-4, 11 and 14-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Pole, II* in view of *Pole, II et al.* (U.S. 6,272,642). Applicants traverse this rejection on the grounds that the references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

> ...The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

Claim 11 includes: A method of transitioning a processor having various power state conditions wherein the processor operates a selectable operating mode, comprising:

providing a north-bridge controller, the north-bridge controller initiating a processor reset signal input;

providing a south-bridge controller, the south-bridge controller;

providing interface for I/O devices to the processor;

resetting the processor; and

providing a clock, a power supply and a logic device, the logic device interfaced to the processor, the clock and the power supply, whereby the logic device provides control signals to the processor to cause a deep sleep transition to the processor immediately after reset.

The references fail to disclose or suggest the claimed combination as set forth in claim 11. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection because neither the *Pole II* nor *Pole II, et al.* patents teach or even suggest the desirability of the combination. Moreover, neither patent provides any incentive or motivation supporting the desirability of the combination.

The MPEP §2143.01 provides:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

The Federal Circuit has, on many occasions, held that was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO " failed to establish a *prima facie* case of obviousness":

> Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffore Hospital,* 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, *e.g., Grain Processing Corp. v. American Maize-Products,* 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet,* 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had "reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention [to have been] obvious." The court noted that to "prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness." The court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved: (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." Here, according to the court, the board had relied simply upon "the high level of skill in the art to provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: "If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance."

Therefore, independent claims 1 and 11 and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1-6, 11 and 14-15 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,

James R. Bell
Registration No. 26,528

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HAYNES AND BOONE, L.L.P.
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 512/867-8407
Facsimile: 214/200-0853
ipdocketing@haynesboone.com

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